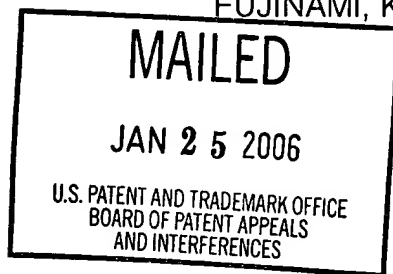


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TOMOSHIGE UMEDA, SHUJI ISHIKAWA, TORU YOSHIHARA, SUSUMU
FUJINAMI, KOJI MIMURA, KENICHI ONO, TSUTOMU MITSUHASHI



Appeal No. 2005-2408
Application No. 09/783,548

HEARD: November 17, 2005

Before FRANKFORT, PATE, and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 6, 8, 9, and 11 to 15, which are all of the claims pending in this application. Claims 2, 7, and 10 have been withdrawn from consideration and claims 3 to 5 have been canceled.

The appellants' invention relates to a mask that supplies steam to the nose and throat (specification, p. 1). A copy of the claims 1, 2, 6 to 14 under appeal is set forth in the appendix to the appellants' brief. The copy of claim 15 contained in the appendix does not include amendments to that claim made in a reply to the Final Office Action. Claim 15 recites:

A mask comprising:

a main mask body; and

heat generating means for generating steam in said main mask body by an exothermic oxidation chemical reaction, wherein said steam generates a therapeutic vapor for inhalation.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Daneshvar	5,205,282	Apr. 27, 1993
Mitra et al. (Mitra)	5,890,486	Apr. 6, 1999

THE REJECTION

Claims 1, 6, 8, 9, and 11 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Daneshvar in view of Mitra.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed May 19, 2004) and for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 12, 2004) and reply brief (filed July 15, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected claims on appeal under 35 U.S.C. § 103 as being unpatentable over Daneshvar in view of Mitra. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The examiner relies on Daneshvar for describing substantially all of the claimed limitations of the appealed claims, except the heat-generating unit comprising an exothermic composition containing metal powder, salt and water and releases steam in conjunction with an oxidation reaction of the metal powder. The examiner relies on Mitra for describing a heat generating unit utilizing an exothermic chemical reaction having salt, water and metal and including an oxidation reaction so as to provide nasal therapy. The examiner concludes:

... it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated Mitra's teaching of an apparatus including exothermic chemical reaction having salt water and metal, and including oxidation reaction into the invention disclosed by Daneshvar, so as to provide for nasal therapy. [Answer at page 4]

We find that Daneshvar discloses a therapeutic nasal inhalator which includes a pan or heater unit 24 for holding hot water. The steam from the hot water rises up in the inhalator passing through a lower chamber 30 through an opening 40 into an upper chamber 32. The user places his or her nose into an aperture 56 and inhales steam (Figs. 1, 12 and 17 col. 4, lines 2 to 6). Daneshvar also discloses that the water in heater unit 24 may be heated by a heater 90 (col. 4, lines 23 to 25).

Mitra describes a nasal dilator which comprises a resilient strip of material which is placed on the outside of the nose and acts to draw the nasal walls apart thereby relieving nasal congestion (col. 3, lines 64 to col. 4, line 10; col. 4, lines 31 to 40). The

strip includes a thermal element 36 capable of providing heat which comprises an exothermic composition comprising oxidation chemistry (col. 4, lines 13 to 17; Fig. 2).

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).


We will not sustain this rejection because in our view, there is no motivation to combine the teachings of Daneshvar and Mitra. The structures respectively disclosed by Daneshvar and Mitra differ markedly in terms of their construction. The heating unit 24 of Daneshvar is intended to contain hot water which produces steam that is inhaled by the user. It is apparent from a reading of the Daneshvar disclosure that the mask and heating unit 24 can be used for an unlimited period of time and for numerous uses by simply maintaining a supply of hot water in the heating unit 24. Mitra on the other hand describes a strip that is placed over the nose which includes a thermal unit 36 comprised of an exothermic substance which remains hot for several hours. As such, it is not apparent to us why a person of ordinary skill in the art would have been motivated to modify the multi use device of Daneshvar so as to be limited to one several hour use. In addition, there is no disclosure in Mitra that the exothermic substance used in the thermal unit 36 releases steam so as to motivate a person of ordinary skill in the art to substitute a thermal unit 36, as taught by Mitra, for the Daneshvar heating unit 24. Likewise, there is no teaching in Mitra that the thermal unit 36 produces enough heat to heat water so that the water produces steam, to motivate a person of ordinary skill in the art to substitute a thermal unit 36, as taught by Mitra, for the Daneshvar heating unit 24. In fact, as the thermal unit 36 is placed close to the skin of the wearer, one of ordinary skill in the art would be lead to believe that the exothermic substance in the thermal unit 36 does not get hot enough to cause water to

produce steam. The only suggestion for combining the disparate teachings of Daneshvar and Mitra so as to arrive at the subject matter of claim 1 stems from hindsight knowledge impermissibly derived from the appellants disclosure.

In view of the foregoing, we will not sustain this rejection. The decision of the examiner is reversed.

REVERSED


CHARLES E. FRANKFORT
Administrative Patent Judge


MURRIEL E. CRAWFORD
Administrative Patent Judge

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PATE, Administrative Patent Judge, Concurring-in-Part and Dissenting-in-Part,

I respectfully dissent as to the reversal of the rejection of claim 15.

I concur with the findings of fact made by my colleagues. Daneshvar discloses a pan or heater unit 24 for holding and heating water. The water is heated in a preferred embodiment by an electric heater 90. Daneshvar is not restricted to an electric heater, of course. In fact, the inventor discusses an alternative heating source using tubing and a source of hot water. Daneshvar differs from the subject matter of claim 15 only to the extent that Daneshvar discloses an electric or tube-supplied hot water heating means rather than a heating means based on an exothermic chemical reaction.

Mitra discloses a different heating means. Mitra provides a source of heating using an exothermic composition based on the oxidation of iron. In my view it would have been obvious to substitute the exothermic heating means of Mitra for the electric heater or hot water supply tube of Daneshvar for the self-evident advantage of making the device usable in a location remote from an electric outlet or hot water supply. In short, I believe it is obvious in this art to substitute one well known heat source for

another. That the exothermic heat source of Mitra is disclosed in a nasal strip is only gilding the lily, so to speak.

I would affirm the rejection of claim 15.



WILLIAM F. PATE, III
Administrative Patent Judge

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Oblon, Spivak, McClelland, Maier, Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

MEC/ki